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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,184	07/11/2001	James A. McFarlin	45565/FLC/M785	1160
23363	7590	10/19/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/904,184	MCFARLIN ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,13-19,21-24,27-36,38-44 and 46-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,13-19,21-24,27-36,38-44 and 46-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-10, 13-19, 21-24, 27-36, 38-44, and 46-51 have been examined.

Response to Amendment

2. The Amendment filed on 9/29/06 is sufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, 2, 4-10, 13-19, 21-24, 27-36, 38-44, and 46-51 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 2, 4-10, 13-19, 21-24, 27-36, 38-44, and 46-51 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claim features a corporate sponsor, franchisor, and retailer. However, the Specification does not adequately disclose the difference between or relationship between a corporate sponsor and a franchisor. Applicant's Specification makes sense that there are corporate sponsors who provide marketing materials that can be used by a franchisee/retailer:

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“A method and apparatus for producing marketing materials for a retail establishment. A corporate sponsor generates marketing material information for use by franchisees in marketing products and services supplied by the corporate sponsor” (Applicant’s Abstract).

However, Examiner could only find one citation from the Applicant’s Specification that defines or describes what are what are the differences between or what are the relationships between a corporate sponsor and a franchisor:

“[0042] FIG. 17 is a diagram depicting. . .The webLSM server is a data processing system coordinating the operations of a retail establishment 110, a printer 170, a corporate sponsor 130, and a franchiser or product manufacturer 120 (a franchiser or a product manufacturer other than the webLSM corporate sponsor is herein termed a franchisor) in order to produce printed marketing materials for use in a retail establishment.”

And, this citation from the Applicant’s Specification obscurely and unclearly defines a franchisor. A franchisor being a franchisor that is not the corporate sponsor does not provide an adequate description of the parts of the Applicant’s Specification of claims in order to adequately describe the invention.

Hence, the Applicant’s Specification and claims are unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1, 2, 4-10, 13-19, 21-24, 27-36, 38-44, and 46-51 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brown (2005/0235201).

Claim 1, 2, 4, 5, 8, 10, 18, 19, 21, 22, 27-29, 35, 36, 38, 39, 42, 44

Brown discloses franchisors, company, manufacturers, retailers, distributors, vendors ([4, 5, 27]) where electronically customizable advertising/marketing material ([2, 4, 5, 6, 7]) can be made electronically available (Fig. 1; Fig. 4) for distributor/vendor/retailers by manufacturer/companies such that the distributor/vendor/retailers can customize the manufacturer/company provided advertising/marketing material (Fig. 6; Abstract). Brown further discloses that the manufacturer can provide different rules/limits ([31]) and that the advertising customized by the retailer/distributor needs can receive approval ([31]). Brown further discloses different levels ([31]) of authority.

Brown does explicitly disclose that the advertising material is presented and/or approved by a company and a franchisor. However, Brown discloses different levels of authority ([31]). Brown further discloses companies, manufacturers, franchisors, and various other parties involved in marketing/advertising of a goods/services ([4, 5, 27]). Brown further discloses a manufacturer coordinating through/across/down its distribution channel ([4]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that various parties involved in marketing/advertising of goods/services can be part of Brown's advertising/distribution channel for a manufacturer and can be involved in providing and/or approving the marketing/advertising material. For example, Brown's individual automobile dealership can be part of a regional dealership, which is part of a national dealership which deals the cars for a manufacturer. Brown's different parties and different levels

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of authority allow different parties to have different access to promotional control. One would have been motivated to do this in order to provide better marketing/advertising material customization possibilities from the local to regional to national level, etc.

Claims 6, 7, 23, 24, 40, 41: Brown discloses the above.

Brown does not explicitly disclose a coupon.

However, Brown discloses a variety of approved marketing, advertising, and promotional materials ([5, 26]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Brown's approved promotional materials can include a coupon. One would have been motivated to do this in order to provide a form of promotional material that better incites user attention and response.

Claims 9, 13, 14, 30, 31, 43, 47, 48: Brown disclose the above. Brown further discloses utilizing different resolutions ([27]).

4. Claims 15-17, 32-34, 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (2005/0235201) in view of Evans (2002/0036654).

Claims 15-17, 32-34, 49-51: Brown discloses the above. Brown does not explicitly disclose scheduling printing. However, Evans discloses tracking user design creation and printer orders and scheduling printer jobs (Evans, [89 thru 95]). Evans further discloses a variety of communications mediums (Evans [27, 54]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Evans tracking and print scheduling and variety of communications mediums to Brown's different communicating

parties and order the manufacture/printing of designs. One would have been motivated to do this in order to better allocate the printing of designs.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Please see the new 35 USC 112 rejection and 35 USC 103 rejection above. Also, please see the comments below.

On page 14 of the Applicant's Remarks/Arguments dated 9/29/2006, Applicant states, "The claims are clearly allowable over the combined teachings of Mitchell and Evans because neither reference discloses or suggests the computer implemented steps of interacting with the franchisor and corporate sponsor in producing final designs and in obtaining their approval." Please see the 35 USC 103 rejection of the independent claims above to see how these features are rendered obvious.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where

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the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, USPQ 12 (CCPA 1977).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
10/2/2006.